

REMARKS

By this amendment, claims 25-27, and 29-61 are pending, in which claim 28 is canceled without prejudice or disclaimer, claims 25, 33, and 41 are currently amended, and claim 61 is newly presented. Claims 1-24 were previously canceled without prejudice or disclaimer. No new matter is introduced.

The Office Action mailed February 24, 2009 rejected claims 25-32 and 49-52 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement, claims 25-48 under 35 U.S.C. § 102(a) as being anticipated by *Chung et al.* (US Pub. 2002/0078153), and claims 49-60 under 35 U.S.C. § 103(a) as being unpatentable over *Chung et al.* in view of *Gourraud* (US Pub. 2004/0037406).

Regarding the rejection of claims 25-32 and 49-52 under 35 U.S.C. § 112, first paragraph, Applicant respectfully traverses such rejection. The Office Action alleges that a “computer readable medium” in claims 25-32 and 49-52 constitutes new matter. It is noted, however, that “[n]ot every last detail is to be described, else patent specifications would turn into production specifications, which they were never intended to be.” *In re Gray*, 309 F.2d 769, 774 (C.C.P.A. 1962). In fact, “[a] patent is not a scientific treatise, but a document that presumes a readership skilled in the field of the invention.” *Ajinomoto Co. v. Archer-Daniels-Midland Co.*, 228 F.3d 1338, 1347 (Fed. Cir. 2000), *cert. denied*, 532 U.S. 1019 (2001) (citing *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1556 (Fed. Cir. 1983) (holding that “[p]atents, however, are written to enable those skilled in the art to practice the invention, not the public”), *cert. denied*, 469 U.S. 851 (1984)). With respect to computer programs and mediums for storing such programs, an applicant need only describe the functional aspects and the execution of those aspects by, for example, a device (e.g., computing hardware) in order for one of ordinary skill in

the art to understand that such functions may be carried out by a computer program embodied on a computer-readable medium. *See, e.g., Robotic Vision Sys. v. View Eng'g, Inc.*, 112 F.3d 1163, 1166 (Fed. Cir. 1997); *Fonar Corp. v. General Elec. Co.*, 107 F.3d 1543, 1549 (Fed. Cir. 1997); *In re Hayes Microcomputer Prods., Inc.*, 982 F.2d 1527, 1537-38 (Fed. Cir. 1992).

With these legal tenants in mind, Applicant particularly notes that the disclosed embodiments have been thoroughly described with respect to communications, for example, involving a server, (*See, e.g., FIG. 3 and accompanying text*), and multiple terminals. It is well-known that a server is a computer that would utilize a computer readable medium to run certain instructions in performance of certain functions. Additionally, one of ordinary skill in the art would know that the communication terminals (*see FIGs. 1a and 1b*) possess logic to perform computing functions and that such functions would be captured in a computer readable medium.

Accordingly, the § 112, first paragraph written description rejection should be withdrawn.

With respect to the rejection of claims 25-48 under 35 U.S.C. § 102(a), to reduce issues for potential appeal, Applicant has amended independent claims 25, 33, and 41. As amended, independent claims 25, 33 and 41 recite, among other features, “wherein the third message comprising the network address is transmitted from the first terminal to the at least one other terminal **by direct communication.**” Even assuming, *in arguendo*, that the “conference server” in the claims could be interpreted as the “communication controller” disclosed in *Chung et al.*, *Chung et al.* merely discloses that a method of joining User B “begins when the SEC client 170 associated with User A sends **an invitation message** such as a SIP INVITE message **to the communication controller**” (*See, e.g., ¶ [0083]*). The communication controller is utilized to facilitate the establishment of a conference, and thus, there can be no direct communication, as positively claimed. Accordingly, Applicant respectfully requests the rejection of independent

claims 25, 33 and 41, as well as claims 26-32, 34-40, 42-48 depending correspondingly therefrom, be withdrawn.

With respect to obviousness rejection of claims 49-60, it is respectfully submitted that the references of *Chung et al.* and *Gourraud*, even assuming they can be properly combined, fail to teach all features of the claims. Independent claims 49, 53, and 57 recite, among other features, “wherein the network address is a **dynamically generated uniform resource identifier**.” The Office Action correctly acknowledges that this feature is absent from *Chung et al.* (Page 10 lines 17-19). In an attempt to cure this deficiency, the Office Action applies *Gourraud*, citing paragraph 24. This passage states the following (Emphasis Added):

[0024] According to the preferred embodiment of the present invention, there is provided a method and system for sending instant messages of various kinds to participants involved into an ongoing conference call, such as for example into a multimedia, Session Initiation Protocol (SIP) based conference call. Although various types of identifiers may be used, the conference call is preferably identified by a Uniform Resource Identifier (URI). **The conference call URI is dynamically updated** during the ongoing conference call so that it is always associated to the participants currently involved in the conference call. When one of the participants to the conference desires to send an instant message to the other participants, the instant message is directed to the conference URI. An Application Server receives the message and translates the conference URI into the identities of the current participants, such as for example in their Public IDs. Then, the instant message is sent to each one of the current participants of the conference call. According to the invention, the instant message sent during the ongoing conference call may be of any kind, such as for example text, audio, video, data file, graphical or a combination thereof.

The above passage describes that the **update** of the conference call URI is dynamic. This is different than “wherein the network address is a dynamically **generated** uniform resource identifier.” In other words, a process for updating is different than generating. This distinction is clear, given the full context of the claims: “transmitting to the first terminal a second message comprising **the network address that identifies the resource capable of sustaining the**

conference call, wherein **the network address is a dynamically generated** uniform resource identifier.”

In view of the foregoing, Applicant respectfully submits that no *prima facie* case of obviousness has been established, and request withdrawal of the rejection.

Turning now to newly added claim 61, this claim depends from amended claim 33, and thus, is allowable for the reasons proffered above. In addition, claim 61 is allowable on its own merits, as it recites “wherein in the conference call is established in **an ad hoc** manner.”

Therefore, the present application, as amended, overcomes the rejections of record and is in condition for allowance. Favorable consideration is respectfully requested. If any unresolved issues remain, it is respectfully requested that the Examiner telephone the undersigned attorney at (703) 519-9952 so that such issues may be resolved as expeditiously as possible.

To the extent necessary, a petition for an extension of time under 37 C.F.R. §1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 504213 and please credit any excess fees to such deposit account.

Respectfully Submitted,

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May 22, 2009
Date

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